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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,308	01/19/2001	Takanori Terada	1046.1232/JDH	6758
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER CHRISTENSEN, SCOTT B	
			ART UNIT	PAPER NUMBER
			2444	
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			04/01/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/764,308

**Applicant(s)**

TERADA, TAKANORI

**Examiner**

Scott Christensen

**Art Unit**

2444

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6, 8-11, 13-15, 17-20, 22-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-11, 13-15, 17-20, 22-24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is in regards to the most recent papers filed on 1/14/2009.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/14/2009 has been entered.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4-6, 8-11, 13-15, 17-20, 22-24, and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (U.S. Pat. No. 6,952,805), hereinafter referred to as "Tafoya."
5. Regarding claim 1, Tafoya discloses an E-mail device comprising:  
a first detection module detecting that a combination of mail destination addresses respectively specified by a user exists in a history of mail delivery (see

column 2, lines 25-28; column 6, lines 51-63; column 7, lines 23-64. The user inputs the addresses in to the system according to column 2, lines 28-31.);

a setting module setting an input count of the combination of detected multicast target mail destination addresses in the history (see column 2, lines 25-28, 42-54; column 4, lines 57-67; column 6, line 65 through column 7, line 21; column 7, line 65 through column 8, line 18; column 13, lines 30-36);

a generating module generating a group formed of the combination of multicast target mail destination addresses detected in the history, when the input count of the combination of detected multicast target mail destination addresses reaches a predetermined number (see column 2, lines 25-41; column 6, line 65 through column 7, line 21; column 7, line 9-21; column 9, lines 27-39); and

an adding module adding a group name of the generated group to group management information in said history of mail delivery (see column 4, lines 34-49).

6. Regarding claims 10 and 19, the instant claims are substantially similar to claim 1, and are rejected for substantially similar reasons.
7. Regarding claims 2, 11, and 20, Tafoya disclosed the method and system further comprising detecting that there does not exist a group corresponding to the plurality of multicast target mail destination addresses existing in the history (see column 7, lines 1-8); and if there does not exist a group corresponding to the plurality of multicast target mail destination addresses, generating the group (see column 4, lines 34-49).

8. Regarding claims 4, 13, and 22, Tafoya disclosed the method and system further comprising registering the added group name corresponding to the plurality of multicast target mail destination addresses (see column see column 7, lines 1-21).

9. Regarding claims 5, 14, and 23, Tafoya disclosed the method and system further comprising registering the added group name inputted by a user in the group management information in the registering the added group name (see column 3, line 61 through column 4, line 5).

10. Regarding claims 6, 15, and 24, Tafoya disclosed the method and system further comprising registering a piece of registration reject state information in the group management information when the user rejects the registration of the added group name in the registering the added group name (see column 11, lines 8-22).

11. Regarding claims 8, 17, and 26, Tafoya disclosed the method and system further comprising generating the group name by a predetermined algorithm and adding the generated group name to the group management information (see column 9, lines 50-65).

12. Regarding claims 9, 18, and 27, Tafoya disclosed the method and system further comprising enabling a user to select whether the generating the group is to be executed or not (see column 11, lines 42-50).

***Response to Arguments***

13. Applicant's arguments filed 1/14/2008 have been fully considered but they are not persuasive.

14. Applicant's arguments focus on the phrase "generating a group formed of the combination of multicast target mail destination addresses." However, this phrase is currently amended, and is addressed in the rejection above. Further, the arguments have been addressed in the advisory action mailed 11/14/2008.

15. **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Christensen whose telephone number is (571)270-1144. The examiner can normally be reached on Monday through Thursday 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. C./  
Examiner, Art Unit 2444

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444